

Application No. 10/786,727  
Amendment dated February 13, 2006  
Reply to Office Action of October 13, 2006

Docket No.: 65937-0045

### **REMARKS**

The present amendment is intended to be fully responsive to the Office Action having a mailing date of October 13, 2006, wherein claims 1-26 have been rejected and are currently pending. By this amendment, claims 1, 6, 9, 10, 14, 19, 22, 23 have been amended and no claims have been canceled. Applicant submits that no new matter has been added by this amendment and that support for the claims, as amended, may be found throughout the specification and drawings.

At least for the reasons set forth below, Applicant respectfully traverses the foregoing rejections. Further, Applicant believes that there are also reasons other than those set forth below why the pending claims are patentable, and reserve the right to set forth those reasons, and to argue for the patentability of claims not explicitly addressed herein, in future papers. Applicants respectfully requests reconsideration of the present application in view of the above amendment, the new claims, and the following remarks.

### **Claim Objections**

Claims 6 and 19 were objected to due to informalities. Applicant has amended claims 6 and 19 to address the informalities raised by the Examiner. Withdrawal of the objection is therefore respectfully requested.

### **Claim Rejections – 35 U.S.C. § 112**

Claims 9, 10, 22 and 23 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended claims 9, 10, 22 and 23 to further clarify the scope of the respective claims. Withdrawal of the rejection is therefore respectfully requested.

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**Claim Rejections – 35 U.S.C. § 103**

**A. Privatera in view of Moore**

Claims 1-8 and 14-21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Privatera et al. (U.S. Patent No. 6,273,862) in view of Moore (U.S. Patent No. 2,866,457). Applicant respectfully traverses the rejection.

“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). However, Privatera et al, alone or in combination with Moore, fails to teach all of the limitations in claims 1-8 and 14-21.

More specifically, the Examiner contends that Privatera et al. discloses a biopsy system that communicates saline and/or an anesthetic to a piercer. As admitted by the Examiner, Privatera et al. does NOT disclose a fluid connector that includes two check valves configured to provide two fluids in communication with the biopsy device. And Privatera et al. certainly does not teach, disclose or suggest a first check valve that is integrated within the fluid connector or a second check valve that is integrated within the fluid connector as positively claimed by Applicant in amendment claims 1 and 14.

Nor does Moore make up for the deficiencies of Privatera et al. In contrast the Applicant's invention, as defined by claims 1 and 14, Moore discloses a length of tubing 8 that is connected to a check valve 9. The check valve 9 is connected *by tubing* 10 to a Y-connection 11. Indeed, as may be seen in Figure 1, the check valve 9 is not integrated within the Y-connection 11, as positively claimed by Applicant in claims 1 and 14. Thus, the combination of Privatera et al. and Moore fails to obviate Applicant's invention.

Dependent claims 2-8 and 15-21 are allowable over Privatera et al., alone or in combination with Moore by virtue of their dependency upon claims 1 and 14. However, the dependent claims each contain additional features that are also not found in either reference. For example, claim 3 requires that the second check valve includes a resiliently compressible valve

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member. While the Examiner states that the check valves of Moore "comprise resiliently compressible valve members (*around and including spring 25 in figure 1*) secured in a valve seat (*around 25 in figure 1*), a reading of the specification reveals no such disclosure. Indeed, Moore teaches the use of a disc 31 supported on several lugs 35. Col. 2, lines 24-28. Moore further recites that a spring 25 may be used to apply pressure on the valve. No where does Moore state that the valve member of Moore itself may be "resiliently compressible as claimed in claims 3 and 16.

As the combination of Privitera et al. and Moore clearly fails to teach all of the limitations of the claims, withdrawal of the rejection is respectfully requested.

**B. Privitera in view of Moore, in further view of Turturro et al.**

Claims 11, 13, 24 and 26 were rejected under 35 U.S.C. 103(a) as being unpatentable over Privitera et al. (U.S. Patent No. 6,273,862) as modified by Moore (U.S. Patent No. 2,866,457), as applied to claims 1-8 and 14-21 above, and further in view of Turturro et al. (U.S. Patent No. 6,331,165). Applicant respectfully traverses the rejection.

Claims 11 and 13 depend upon claim 1 and claims 24 and 26 depend upon claim 14. The arguments made above in connection with the Privitera et al./Moore combination is equally applicable to this rejection, as well. Nor does Turturro make up for the deficiencies of the Privitera et al./Moore combination. Turturro certainly does not teach, suggest or disclose the limitations of a first check valve that is integrated within the fluid connector or a second check valve that is integrated within the fluid connector as positively claimed by Applicant in amended claims 1 and 14. As claims 11, 13, 24 and 26 are dependent upon claims 1 and 14, which define over the combination, these claims are allowable as well. Accordingly, withdrawal of the rejection is respectfully requested.

**C. Miller et al. in view of Moore**

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Claims 1-10, 12, 14-23 and 25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al. (U.S. Patent Publication No. 2002/0082519) in view of Moore (U.S. Patent No. 2,866,457). Applicant respectfully traverses the rejection.

As an initial matter, the Examiner has failed to provide any motivation to modify Miller et al. with the teachings of Moore. As is known, "[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure." *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Further, "[a] reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out by the reference." *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). In performing a 35 U.S.C. §103 analysis, it is error to consider "references in less than their entireties, i.e. in disregarding disclosures in the references that diverge from and teach away from the invention at hand." *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 721 F.2d 1540, 1550, 220 USPQ 303, 311 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

In this instance, it is noted that the Examiner asserts that a first fluid connector is provided "around 402," even though no such connector is shown. The Examiner also asserts that a second fluid source is disclosed in paragraph 90. Indeed, Miller et al. actually teaches an irrigation lumen that is connected to a hub 140 (see, figure 9). Thus, as Miller clearly already provides two separate fluid sources that are in communication with the biopsy device, there would be no motivation to look to Moore to provide a fluid connector for two separate fluid sources. Thus, Miller et al. teaches away from the combination.

Second, the Miller et al./Moore combination also fails to disclose all of the limitations recited in the claims. More specifically, the Miller et al./Moore combination fails to teach, disclose or suggest a first check valve that is integrated within the fluid connector or a second check valve that is integrated within the fluid connector as positively claimed by Applicant in amendment claims 1 and 14. Further, as claims 2-9, 12, 15-23 and 25 are dependent upon either

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claim 1 or 14, these claims are also patentable simply by virtue of dependency. Accordingly, withdrawal of the rejection is respectfully requested.

### CONCLUSION

Reconsideration and allowance are respectfully requested. In view of the above, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Any fee is due with this response is identified in the accompanying transmittal. As indicated, please charge our Deposit Account No. 18-0013, under Order No. 65937-0045 from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. § 1.136 is hereby made, the fee for which should be charged to such deposit account number.

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Respectfully submitted,

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